

REMARKS

Claims 1-30 are pending. By this response, claims 1, 18 and 30 are amended. Reconsideration and allowance based on the above-amendments and following remarks are respectfully requested.

Applicants appreciate the indication of claims 15-17 and 26-29 as being allowed and claims 8, 9, 11, 12 and 21-24 as containing allowable subject matter.

112, Second Paragraph

The Office Action rejects claims 1-14, 27 and 28 under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Office Action alleges the limitation “the user unit” in line 6 lacks antecedent basis. Applicants have amended claim 1 changing the limitation “the user unit” to “the pen device” to provide proper antecedent basis.

Regarding claims 27 and 28, the Office Action alleges that the limitation “the user” in lines 1 and 2 lacks in sufficient antecedent basis. In response, applicants direct the Examiner’s attention to claim 26 which recites “a method for providing memory capacity for a user of a hand held pen device.”

Applicants note that claims 27 and 28 are dependent upon claim 26 and thus proper antecedent basis is provided in the first sentence of claim 26 for “the user”.

In view of the above, applicants respectfully request reconsideration and withdrawal of the rejection.

Prior Art Rejection

The Office Action rejects claims 1-7, 10, 13, 14, 18-20, 25 and 30 under 35 U.S.C. §103(a) as being unpatentable over Lazzouni, et al. (US 5,661,506) in view of O'Conner, et al. (US 6,188,392). This rejection is respectfully traversed.

Claimed Features Not Taught

Lazzouni discloses an imaging pen that includes an attached imaging system that generates images of the writings created by the pen and outputs these writings to an external recording/processing unit. See Figs. 10-12 and column 4, lines 22-26. The receiving unit then processes the images to obtain positioned information that reflects the movement pattern of the imaging pen. This information is then stored in a memory 146 of the external recording/processing unit. See Figs. 10-11, column 9, lines 6-47. Lazzouni's system does not teach a pen having an internal memory. This lack of teaching within Lazzouni is admitted by the Examiner. The Examiner provides O'Conner to provide the teaching of an internal memory.

O'Conner, discloses the use of an electronic pen having internal accelerometers. The pen samples data from the accelerometers and stores

intermediate data representative of the X, Y acceleration and pressure, in an internal memory unit. The intermediate data is later processed into position data in an external processing device. See column 4, lines 32-37 and column 5, lines 8-12. As illustrated in Fig. 2 of O'Conner, the pen can communicate with an external device either via a docking station or via a wireless communications interface. In each of these operations, a user controls the transmission of the data from the internal memory of the pen to an external device. O'Connor teaches the reading of the pen internal memory by an external device, (see column 8, lines 10-30) not by the transmission from and internal memory to an external memory, let alone by an automatic transfer. O'Conner does not teach or suggest the automatic transfer of data in an internal memory of a pen to an external memory.

O'Conner suggests, to the contrary of the present invention, that the memory capacity of a pen should include enough memory to store data of most users over the course of the day. See column 1, lines 50-55. Thus, O'Conner implies that the content of the memory in the pen of O'Conner is transferred to the external device at a time of the users choosing, i.e. whenever the user has the opportunity to perform a physical or wireless docking operation.

Neither Lazzouni nor O'Conner, teach automatic transfer of data from a first internal pen memory to a second external memory. Specifically, within Lazzouni, the internal memory of the pen is not taught and within O'Conner,

the amount of data recorded is limited to the capacity of the memory within the pen and the data is not automatically transferred to an external memory.

Therefore, the storage capacity of the internal memory of O'Connor is limited and thus, the memory cannot be exceeded, unlike the present invention in which the first memory unit can exceed its limit by the automatic transfer of data. Thus, the combination of Lazzouni and O'Connor cannot teach all the claimed limitations in independent claims 1, 18 and 30 as required.

Therefore, the combination of Lazzouni and O'Connor fail to teach or suggest in the pen device environment, *inter alia*, a first memory unit located in the pen device and a second memory unit located in an external data storage device, which memory units are connected in such a way that a transmission of said recorded information is caused to occur automatically from the first memory unit to the second memory unit, and through transmission of the recorded information from the first memory to the second memory, the recorded information can exceed the storage capacity of the first memory and thereby, from the point of view of the user, the first memory and second memory form a coherent memory unit, as recited in claims 1 and 18 (emphasis added).

Also, the combination of Lazzouni and O'Connor fails to teach or suggest, *inter alia*, transferring at least a subset of the recorded information from the first memory unit to a second memory unit in an external data storage device

in such a way that a transmission of said recorded information is caused to occur automatically from the first memory unit to the second memory unit, and the recorded information can exceed the storage capacity of the first memory , as recited in claim 30 (emphasis added).

Applicants note that the above claim language is similar to the claim language of allowed claim 15. Claims 1, 18 and 30 have been amended to overcome the cited references in consideration of allowable features recited in allowed claim 15.

#### Lack of Motivation

Further, one of ordinary skill in the art would not be motivated to combine the teachings of Lazzouni and O'Conner. Applicants remind the Examiner that motivation to combine teachings must be found within the references themselves or by one of ordinary skill in the art. In the Office Action, the Examiner states that motivation is provided to combine the teachings of Lazzouni with O'Conner because "this would provide an improved compact pen input device, which has a memory for conveniently and effectively recording pen input information for transmitting to a computer, and which is autonomous and easily to use." Nowhere in Lazzouni or O'Connor does it suggest modify their teachings to include an internal memory within a pen

device and an external memory in which transferring of data is automatically performed between the two memories, let alone for convenience or ease of use.

Further, one of ordinary skill would not look to these two references to achieve applicants claimed features since the references fail to teach all the claimed limitations required to make such a combination and in fact teach to the contrary. Lazzouni teaches storing large amounts of data in an external memory, while O'Connor teaches transferring data at the discretion of a user. Neither reference teaches or suggests an internal and external memory in which automatic transfer of data between the memories occurs.

### Conclusion

Therefore, in view of the above, applicants respectfully submit that the combination of Lazzouni and O'Conner fail to satisfy the requirements for the rejection under 35 U.S.C. §103. As indicated above, the combination of Lazzouni and O'Conner fail to teach each and every feature of the claimed invention and lack motivation to combine the teachings. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

For at least these reasons, it is respectfully submitted that claims 1-30 are distinguishable over the cited art. Favorable consideration and prompt allowance are earnestly solicited.

Appl. No. 09/986,762

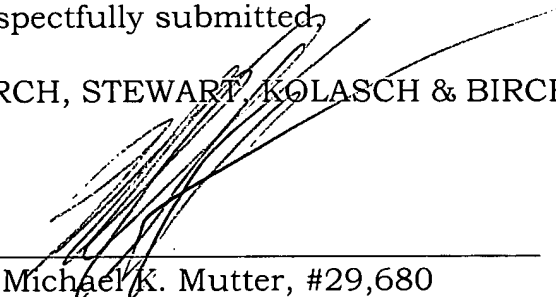
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
Michael K. Mutter, #29,680

MKM/CJB:cb  
3782-0196P

Attachment(s)

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000